

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD E. RATERMAN et al.

Appeal No. 1998-0941
Application No. 08/226,660

HEARD: July 10, 2000

Before STONER, Chief Administrative Patent Judge, and BARRETT and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20-34 and 43-72, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates, in general, to currency identification (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 20-34 and 43-72 stand rejected under the judicially created doctrine of double patenting over claim 15 of U.S. Patent No. 5,295,196.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 13, mailed August 21, 1996) and the answer (Paper No. 24, mailed July 23, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 23, filed April 24, 1997) and reply brief (Paper No. 25, filed September 3, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the

appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected claims 20-34 and 43-72 under the judicially created doctrine of double patenting over claim 15 of U.S. Patent No. 5,295,196, since he believes the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent (answer, p. 3). We do not agree.

In support of the rejection, the examiner determined (answer, pp. 3-5) that the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter and there is no apparent reason why appellants were prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into the patent. In support of this type of rejection the examiner cited (answer, p. 5) In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). In addition, the examiner refers (answer, p. 6) to the Manual of Patent Examining Procedure (MPEP) § 804 as providing support for this type of rejection.

It appears to us that the examiner's rejection is based on an improper application of Schneller.¹ Schneller is a very

¹ Schneller is a rather unusual case in that there was no majority opinion because only Judges Rich and Smith joined the principal opinion, while Judges Worley and Kirkpatrick concurred in the result and Judge Almond wrote a concurring opinion. Thus, the principal opinion therein is of doubtful controlling precedent. As Judge Rich observed in In re Kaplan, 789 F.2d 1574, 1578, 229 USPQ 678, 682 (Fed. Cir. 1986):

The development of the modern understanding of "double patenting" began in the Court of Customs and Patent Appeals (CCPA) about the time of In re Zickendraht, 319 F.2d 225, 138 USPQ 22 (CCPA 1963), a rather unusual case is [sic, in] that there was no majority opinion because only two judges joined each of the two principal opinions. Neither opinion therein, therefore, can be regarded as controlling precedent in this court.

special case of "obviousness-type" double patenting.² The United States Patent and Trademark Office has applied the term "non-obviousness-type" (as opposed to "obviousness-type") double patenting to the factual situation in Schneller in the past, MPEP § 804 (6th ed. Jan. 1995), pages 800-15, -16, but does not now use this label, MPEP § 804 (7th ed., Rev. 1, Feb. 2000), pages 800-21 through 800-23 (classifying double patenting as either "same invention" type or "non-statutory-" type where "non-statutory-type" could include a rejection which is not the usual "obviousness-type" double patenting). MPEP § 804 (7th ed.,

² All types of double patenting which are not "same invention" double patenting have come to be referred to as "obviousness-type" double patenting. See In re Van Ornum, 686 F.2d 937, 942-43, 214 USPQ 761, 766 (CCPA 1982), which states in discussing cases leading to the restatement of the law of double patenting set forth in In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 621-22 (CCPA 1970):

numerous cases were considered in which application claims were directed to mere obvious modifications of, or improvements on, inventions defined in the claims of patents already issued to the same inventors, or to common assignees, and it had been decided that they might be allowed to go to patent if the applicants filed terminal disclaimers. We classified these as "obviousness type double patenting." This latter classification has, in the course of time, come, somewhat loosely, to indicate any "double patenting" situation other than one of the "same invention" type.

See also General Foods Corp. v. Studiengesellschaft Kohl mbH, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1844-45 (Fed. Cir. 1992).

Rev. 1, Feb. 2000) now provides that "non-statutory-type" double patenting of Schneller applies to those situations where: (1) the subject matter recited in the claims of the application is fully disclosed and **covered** by a claim in the patent (i.e., there has been no improvement or modification invented after filing and the application claim reads on subject matter which has been protected by a patent claim); and (2) there is no reason why the appellants were prevented from presenting the same claims for examination in the issued patent (i.e., there is no justification for extending the protection, such as the existence of a restriction requirement); and (3) no terminal disclaimer has been filed.

The condition of Schneller that the subject matter recited in the claims of the application is fully **covered** by a claim in the patent is not satisfied in this instance as clearly shown by the appellants' comparison of patent claim 15 and the claims under appeal (brief, pp. 12-15). In that regard, the claims under appeal set forth structure (i.e., the means set forth in the last paragraph of each of claims 20, 43 and 65) that is not present in patent claim 15. As noted by the appellants, the "controlling means" of patent claim 15 is controlling the

movement of the selected bill (i.e., the bill whose denomination has been determined by the signal processing means) whereas the claims under appeal set forth means which control the movement of the next upstream bill (i.e., the bill upstream from the selected bill).

It is our view that insofar as Schneller is concerned, this case does not, as it appears the examiner would have us believe, stand for the proposition that simply because the subject matter recited in the claims on appeal was disclosed in the application from which the patent matured and the events which gave rise to the situation were the result of the appellants' doing, judicially created doctrine of double patenting would apply if the application claims were allowed to issue. The ruling in Schneller that double patenting existed was based upon a factual situation which is not present here, from which the court found the inventions not to be independent and distinct. It is our view that Schneller did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. In fact, the Court in Schneller, 397 F.2d at 355, 158 USPQ at 215, cautioned against the tendency to

freeze into rules of general application what, at best, are statements applicable to particular fact situations.

The appellants have stated (reply brief, p. 3) that the claims under appeal and patent claim 15 "are directed to patentably distinct inventions." The examiner has not contested that statement. Moreover, from the evidence before us in this appeal, it is appears to us that the patent claims and the application claims are directed to two separate inventions, and that the issuance of the application claims will not extend the exclusivity of the rights granted beyond the term of the patent.

For the reasons set forth above, we will not sustain the examiner's rejection of claims 20-34 and 43-72 based on the judicially created doctrine of double patenting.

REMAND

We remand this application to the examiner to determine whether or not the claims under appeal comply with the requirements of the second paragraph of 35 U.S.C. § 112. In that regard, the claims under appeal all recite that the signal processing means determines the denomination of "each scanned

bill." This limitation appears to conflict with the appellants' application (see Figure 8 and pp. 27-28) which provides that in some instances the denomination of the scanned bill cannot be determined resulting in a "no call" code. Furthermore, it appears from the application (see Figure 8A and pp. 30-34) that the means set forth in the last paragraph of claims 20, 43 and 65 is responsive to this "no call" code rather than the means which determines the denomination of "each scanned bill." The examiner should determine whether these possible problems cause any of the claims under appeal to be indefinite under 35 U.S.C. § 112, second paragraph.

CONCLUSION

To summarize, the decision of the examiner to reject claims 20-34 and 43-72 under the judicially created doctrine of double patenting over claim 15 of U.S. Patent No. 5,295,196 is reversed. In addition, the application has been remanded to the examiner to determine whether or not the claims under appeal comply with the requirements of the second paragraph of 35 U.S.C. § 112.

REVERSED; REMANDED

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	APPEALS
)	AND
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

BARRETT, Administrative Patent Judge, concurring.

I concur with the majority decision, but write separately to express additional views on In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) and its application to the facts of this case.

In my view, assuming Schneller is controlling precedent (see footnote 1 of Administrative Patent Judge Nase's opinion), Schneller represents a factually unique case of "obviousness-type" double patenting and should not be treated as a third category of double patenting, i.e., as a second kind of "non-statutory-type" double patenting as discussed in Manual of Examining Procedure (MPEP) § 803 (7th ed., Rev. 1, Feb. 2000). Schneller is not the usual "obviousness-type" double patenting case because it "is not a case of an improvement or modification invented after filing," Schneller, 397 F.2d at 353, 158 USPQ at 214. Schneller is a situation where an applicant voluntarily files a divisional application (i.e., the disclosure is identical) and not in response to a restriction requirement from the Patent and Trademark Office. In such a case, an applicant is

not entitled to the safeguard of 35 U.S.C. § 121, third sentence, against an "obviousness-type" double patenting rejection.

Schneller disclosed an invention relating to a wire clip having three elements (A, B, and C) known in the prior art, the combination ABC, and two features (X and Y) which he had invented that could be used separately, ABCX or ABCY, or in combination, ABCXY. Schneller acknowledged the best mode of his invention used the two features (X and Y) in combination, i.e., ABCXY. The claims of the patent were directed to a wire clip comprising BCX and ABCX. Schneller voluntarily filed a division claiming wire clips comprising ABCY and ABCXY.

The subject matter ABCXY was fully disclosed as the best mode and was "covered" by the patent claim ABCX (since this claim had "comprising" language that did not exclude other structure). The court concluded that "[t]he claims on appeal, which are directed to the combinations ABCY or ABCXY, would therefore continue protection on the preferred embodiment of the invention, ABCXY, disclosed in the patent, beyond the expiration date of the patent," id. at 355, 158 USPQ at 215.

In my opinion, Schneller does not support the proposition that there is "obviousness-type" double patenting per se (i.e., without any obviousness analysis) whenever the application claim recites elements in addition to those recited in the patent claims. Domination (when one claim reads on or "covers" a later claim) is not, per se, double patenting. See In re Kaplan, 789 F.2d 1574, 1577, 229 USPQ 678, 681 (Fed. Cir. 1986). As stated in In re Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring):

To sum it up, the operation of the rule [of obviousness-type double patenting] is that claims to inventions closely related to the invention claimed in the patent and not patentably distinguishable therefrom must be included in the same patent unless the applicant has been forced to make them in a separate application by a requirement of restriction, in which case section 121 of the statute acts to waive the rule.

Applicants are not required to claim every invention that could be claimed in a single application, which is what a mechanical application of Schneller would essentially require.

Schneller involves two special factual circumstances which limit its general application: (1) the preferred embodiment and best mode of the clip were disclosed to be ABCXY, which indicated that the patent claim ABCX intended to protect the combination

ABCXY (see Schneller, 397 F.2d at 356, 158 USPQ at 216: "Anyone undertaking to utilize what [Schneller] disclosed in the patent . . . , in the preferred and only form in which he described these clips [ABCXY] would thus run afoul of a still unexpired patent if the appealed claims [to ABCXY and ABCY] were allowed."); and (2) the fact that the patent had issued eight years before, which made it appear that he was seeking to impermissibly extend the period of patent protection. Schneller should be limited to similar factual situations.

Therefore, it is the Examiner's duty to present obviousness reasoning to address the differences between the patent claim and the claimed subject matter. The Examiner cannot just rely on the fact that the application recites elements in addition to those recited in the patent claims because this confuses domination with double patenting. That is, if the patent (and the application) disclose A, B, C, X, Y, and Z, and the patent claims ABC, it is not sufficient to say that an application claim to ABCXYZ is unpatentable for double patenting because ABC covers ABCXYZ, and because ABCXYZ could have been claimed.

In this case, the Examiner fails to address the obviousness of the differences between patent claim 15 and the claimed subject matter, in particular, controlling the deceleration so that the next upstream bill is scanned by the scanning head. Appellants have stated why the application claims are patentably distinct from the patented subject matter (Brief, pages 12-15) and these arguments should be addressed. I would further note that the differences include limitations which are present in the patent claims, but are not part of the application claims and, therefore, the application claims are not technically covered by the patent claims.

LEE E. BARRETT) BOARD OF PATENT
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